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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,928	02/29/2000	Bert Whitmore Elliott	24673A	1357
7590 10/11/2006				
OWENS CORNING 2790 COLUMBUS ROAD BUILDING 54 GRANVILLE, OH 43023				
EXAMINER CANFIELD, ROBERT				
ART UNIT		PAPER NUMBER		
3635				

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/515,928	Applicant(s) ELLIOTT, BERT WHITMORE	
	Examiner Robert J. Canfield	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,46-48 and 52-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17,46-48 and 52-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/27/06 has been entered. Claims 17, 46-48 and 52-70 are pending. Claims 1-16, 18-45 and 49-51 have been canceled.

2. The amendment filed 07/27/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: U.S. application serial number 09/292,488, now USP 6,253,512, incorporated by reference does disclose a predominant color blend in roughly 60% of the tabs but fails disclose the complete range of "over 50%", or the specific percents of 55%, 56% or 58%.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 52-54, 62-64 and 69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to describe or discuss the specific percentiles now claimed. This is a new matter rejection. U.S. application serial number 09/292,488, now USP 6,253,512, incorporated by reference does disclose a predominant color blend in roughly 60% of the tabs but fails disclose the complete range of "over 50%" (claims 52, 62 and 69).

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,014,847 to Phillips in view of U.S. Patent 1,843,370 to Overbury.

Phillips provides laminated shingles having an overlay member 12 provided with generally rectangular tabs 20a-20c of different sizes, which are separated by cutouts 22a-22c. The figures show three tabs. The widths of the cutouts are considered sufficiently narrow to simulate slate tiles. Further, the reference states that the widths of the tabs may be varied depending on the desired appearance, which would suggest that the tabs could have been made wider which would result in narrower cutouts. The overlay 12 is laminated to an underlay 14 which is provided a layer of granules substantially darker than that those of the overlay.

The lower edge of overlay member is shown generally co-linear with the lower edge of the underlay member.

Phillips fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Phillips also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Phillips could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect. Phillips teaches at the top of column 4, that it should be understood that different color arrangements could be used. The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material. The

particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed and in fact never even mentions the percentiles now claimed.

7. Claims 17, 46-48 and 52-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,195, 290 to Hulett in view of U.S. Patent 1,843,370 to Overbury.

Hulett provides laminated shingles having overlay members provided with a plurality of generally rectangle tabs (figures 5, 6, and 8) separated by cutouts and underlay members provided with darker granules for a more pleasing appearance (column 4, lines 63+). The cutouts are shown narrow when compared to the tabs. The figures show embodiments including at least four tabs. The particular dimensions of about 1 inch for the width of the cutouts and about 6 inches for the width of the tabs is viewed as a choice of design which would have been obvious to one having ordinary skill at the time of the invention. The figures clearly show the cutouts as narrower than the tabs and the particular dimensions would have been nothing other than a design choice to achieve a desired appearance.

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Hulett fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Hulett also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Hulett could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further,

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applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed.

8. Claims 17, 46-48 and 52-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,939,169 to Bondoc et al. in view of U.S. Patent 1,843,370 to Overbury.

Bondoc laminated shingles having overlay members provided with a plurality of generally rectangle tabs 16 and separated by narrow cutouts, which have beveled edges in the embodiment of Figures 4A-4C, and underlay members 11, 15 provided with darker granules. The cutouts are shown narrow when compared to the tabs. The figures show embodiments including at least four tabs. The particular dimensions of about 1 inch for the width of the cutouts and about 6 inches for the width of the tabs is viewed as a choice of design which would have been obvious to one having ordinary skill at the time of the invention. The figures clearly show the cutouts as narrower than the tabs and the particular dimensions would have been nothing other than a design choice to achieve a desired appearance.

Bondoc fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Bondoc also fails to specify gray as the predominant color blend.

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Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Bondoc could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed and in fact never even mentions the percentiles now claimed.

9. Applicant's arguments filed 07/27/06 have been fully considered but they are not persuasive.

In response to applicant's arguments that the three primary references Phillips, Hulett and Bondoc, fail to teach or suggest the predominant tab color blend, and to the argument that Overbury is directed to a single layer shingle rather than a laminated shingle, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The three primary references are used to teach the structure of a laminated shingle having an overlay member provided with tabs and cutouts. The secondary reference Overbury has been provided to show that providing color blends as claimed was known for artistic effects.

Applicant's argument that none of the references teach one of the color blends occurring more frequently or predominantly than the others is not found persuasive. Overbury clearly shows in at least Figure 6 one color blend occurring more predominantly than others. Also, Overbury recites at page 2 lines 94-96 that if desired two or more tabs may be given the same color.

Applicant's argument that none of the references teaches gray as the predominant color so as to simulate a natural slate roof is not found persuasive. Overbury teaches that any or a variety of colors may be chosen and even discusses crush slate as the granular material used on the tabs. Each of which would have suggested the use of the color gray to one having ordinary skill in the art at the time of

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the invention. To have made gray the predominant color would have been obvious if one is attempting to simulate slate as Overbury is.

Applicant's argument that Overbury only teaches a predominant color as an occasional variation of the primary embodiment is not found persuasive. Overbury does provide the teaching and the fact that it may or may not be the preferred embodiment has no bearing on the fact that it is taught.

10. The declaration under 37 CFR 1.132 filed 07/27/06 is insufficient to overcome the rejection of claims as set forth in the last Office action because:

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The PTO must rely upon the applicant to provide hard evidence of commercial success. Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. The declaration claims commercial success of and long felt need for the Bershire ® shingles but fails to provide the required nexus between the claimed invention and the alleged commercial success. There is no evidence that any alleged commercial success is derived from the claimed invention in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. Applicant has failed to show that the claimed

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features are responsible for any alleged commercial success. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed.Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd.Pat. App. & Inter. 1988).

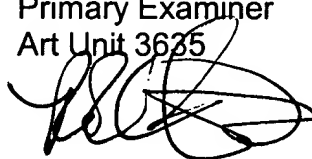
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield
Primary Examiner
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09/29/06

